

REMARKS

Upon entry of the present reply, claims 1-6 remain pending in the application and stand ready for further action on the merits.

Claim Rejection 35 USC § 103(a)

Claims 1-6 were rejected under 35 USC § 103(a) as being unpatentable over Alper et al. US '741 (US 5,149,741) in view of Goulait et al. US '588 (US 5,482,588), and further in view of Fries, et al. US '592 (US 5,549,592). Applicants respectfully traverse the rejection and ask for reconsideration and withdraw of the same based on the following considerations.

Legal Standard for Determining Prima Facie Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). The level

of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In *In re Kotzab*, the claims were drawn to an injection molding method using a single temperature sensor to control a plurality of flow control valves. The primary reference disclosed a multizone device having multiple sensors, each of which controlled an associated flow control valve, and also taught that one *system* may be used to control a number of valves. The court found that there was insufficient evidence to show that one *system* was the same as one *sensor*. While the control of multiple valves by a single sensor rather than by multiple sensors was a "technologically simple concept," there was no finding "as to the specific understanding or principle within the knowledge of the skilled artisan" that would have provided the motivation to use a single sensor as the system to control more than one valve. 217 F.3d at 1371, 55 USPQ2d at 1318.

In *In re Jones*, the claimed invention was the 2-(2'-aminoethoxy) ethanol salt of dicamba, a compound with herbicidal activity. The primary reference disclosed *inter alia* the substituted

ammonium salts of dicamba as herbicides, however the reference did not specifically teach the claimed salt. Secondary references teaching the amine portion of the salt were directed to shampoo additives and a byproduct of the production of morpholine. The court found there was no suggestion to combine these references to arrive at the claimed invention.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

The Present Invention Being Claimed

The invention defined by pending claims 1-6 in the application requires that the materials of the tape tab comprising polypropylene, side flap and hot-melt adhesive be chosen such that the side flap is torn near a joint when pulled at a peel angle of 180° at a speed of 100 m/min. Thus, the tape tab must be made of a material that is more resistant to tearing than the side flap, while the adhesive

must provide a strong enough bond so that the side flap tears before the entire adhesive seal is broken, with the adhesive being a hot-melt adhesive having a melt viscosity of 30 to 100 Pa·s at 140°C.

Distinctions Over the Cited Art of Record

The hot melt adhesive taught by the cited Alper et al. US '741 reference does not have a melt viscosity of 30 to 100 Pa·s at a temperature of 140°C as defined in current claim 1. Therefore, it is submitted that the cited Alper et al. US '741 reference is not capable of achieving the objects of the present invention, i.e., high shear resistance and high peel strength characteristics in adhesion of a fastening tape made of polypropylene and side flaps comprising nonwoven fabric.

The cited Goulait et al. US '588 reference discloses tape tabs made of polypropylene, but the Goulait et al. US '588 reference does not teach or suggest difficulties in adhering the tape tab to the nonwoven fabric by hot melt adhesives. Therefore, a person skilled in the art would not be motivated to combine the cited Alper et al. US '741 reference and the cited Goulait et al. US '588 reference, and would not be motivated to arrive at the instant invention as claimed. Absent such motivation in the cited art, the Examiner's obviousness rejection is not sustainable.

The melt viscosities of the hot melt adhesives used in present invention do not overlap with the melt viscosities of the hot melt adhesives taught in the Alper et al. US '741 reference. This contention is based on data provided in Table II of Alper et al. US '741 (*see* Column 15), which clearly shows that the adhesive formulation of its Example 12, had a viscosity of only 40,900 cP (or 40.9 Pa·s) when tested at 325° F (163° C), which is at the lower end of the instantly claimed range of 30 to 100 Pa·s in instant claim 1.

As to the teachings of the cited Fries, et al. US '592 reference, it is incapable of curing the deficiencies of the cited Alper et al. US '741 and Goulait et al. US '588 references. In this respect, the cited Fries et al. US '592 reference is only being relied upon by the USPTO for its teachings of a disposable undergarment having a tape fastener adhered to a nonwoven side flap, allegedly for a benefit of providing a stronger and more reliable fastening system, with the Examiner citing column 16, lines 36-60, column 17, lines 35-37 and column 1 lines 37-40 of Fries et al. US '592 in support of the obviousness rejection. Thus, since the cited Fries et al. US '592 reference does not cure the deficiencies in the teachings of each of the Alper et al. US '741 and Goulait et al. US '588 references of record, it follows that the combination of cited art references is not capable of rendering the instant invention of pending claims 1-6 patentable. Any contentions of the USPTO to the contrary must be reconsidered.

Conclusion

In view of the above comments, Applicants respectfully submit that pending claims 1-6 are now in condition for allowance. A Notice to such effect is earnestly solicited.

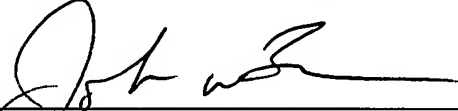
Should there be any outstanding issues to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number of the undersigned, so that further prosecution in this case can be expedited.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: November 23, 2005

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
John W. Bailey, #32,881

JWB/jwb
0445-0320P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000